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10/017,920	12/11/2001	Albert C. Ting	VGEN.005A	7542

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EXAMINER

PREBILIC, PAUL B

ART UNIT PAPER NUMBER

3738

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/017,920

Applicant(s)

TING ET AL.

Examiner

Paul B. Prebilic

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 15-17 and 19-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6 and 11 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-10, 15-17 and 19-28 is/are rejected.
- 7) ☒ Claim(s) 29-31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/1/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 19 is now dependent upon cancelled claim 18 such that its scope cannot be ascertained. For this reason, it will not be evaluated on its merits.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 7, 9, 15-17, 20-22, 23, 26, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Weinschenk, III et al (US 6,599,317). Weinschenk anticipates the claim language where the anterior portion as claimed is lens portion (14) of Weinschenk, the posterior portion is the combination of lens portions (16) and (18) of Weinschenk, the peripheral portion of posterior viewing element is the portion of element (16) that radially extends outside the periphery of element (18) and element (14); see Figures 2 and 3 as well as the abstract and column 7, line 5 to column 9, line 7. The difference in the diameter of portion (14) as compared to portion

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(16) is so substantial in the drawings that the Examiner asserts that the drawings reasonably disclose that portion (16) has a greater diameter than portion (14) to one of ordinary skill; see MPEP 2125. The positive refractive power of the posterior portion periphery is suggested by Weinschenk because the index of refraction for this convex shaped lens is 1.37 to 1.39. Therefore, it reasonably discloses a positive refractive power.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 5, 8, 10, 24, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinschenk III, et al (US 6,599,317) alone.

Regarding claims 2, 8, and 24, Weinschenk discloses the diameter of portion (16) as being 8 to 10 mm but fails to disclose the diameter of portion (14). However, specifying a size for an element is not considered patentable because limitations relating to the size of an element are not sufficient to patentably distinguish over the prior art when there is no clear reason for the specified size or range; see *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) and see MPEP 2144.04(IV) that is incorporated herein by reference.

Regarding claims 5, 10, and 27, Weinschenk discloses a range of 20 to 40 diopters for the anterior portion (see *supra*), but fails to disclose the range of 30 diopters

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or less as claimed. However, the claimed range is considered to be prima fascia obvious over the range disclosed by Weinschenk because it reasonably appears to result in the same effect.

Claims 3 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinschenk, III et al (US 6,599,317) in view of Peyman et al (US 6,277,146).

Weinschenk meets the claim language as explained in the Section 102 rejection above, but fails to disclose the anterior peripheral portion with zero refractive power. However, Peyman et al teaches that it was known to add a light absorbing material to the periphery of the lens (14) to reduce glare created by edge effects. This light absorbing periphery would have no refractive power since it would not transmit light. Therefore, it is the Examiner's position that it would have been prima fascia obvious to add a light absorbing material to the periphery of the Weinschenk lens portion (14) for the same reason that Peyman does the same.

#### ***Allowable Subject Matter***

Claims 6 and 11 are allowed over the prior art of record.

Claims 29 to 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection. In particular, the arguments pertaining

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to the proportional dimensions of the anterior and posterior optics was persuasive and resulted in withdrawal of the rejections base upon Lang and Green.

### ***Conclusion***

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul B. Prebilio whose telephone number is (703) 308-2905. The examiner can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Prebilio  
Primary Examiner  
Art Unit 3738